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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,414	12/16/2005	Masao Yamada	1503.73148	1680
24978 7590 01/28/2009 GREER, BURNS & CRAIN 300 S WACKER DR 25TH FLOOR CHICAGO, IL 60606				
EXAMINER				
HALPERN, MARK				
ART UNIT		PAPER NUMBER		
1791				
MAIL DATE		DELIVERY MODE		
01/28/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/537,414

Applicant(s)

YAMADA, MASAO

Examiner

Mark Halpern

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 5-52 is/are pending in the application.
- 4a) Of the above claim(s) 6-48 and 52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,49-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

- 1) Acknowledgement is made of Amendment received 11/18/2008. Claims 1, 3, 5, 49, 51 are amended and claims 2, 4 are cancelled. Claims 6-48, 52 remain withdrawn. Claims 1, 3, 5, 49-51 are under consideration.

Information Disclosure Statement

- 2) The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

The prior art references recited in the Specification (as, for example, recited on Pages 2-4) are to be listed on form PTO-1449 and copies of foreign references are to be provided for review.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- 3) Claims 1, 3, 5, 49-51 are rejected under 35 U.S.C. 112, first paragraph, as failing

to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 now recites phrase "in which a ratio between a weight of the waste paper to be disintegrated and a weight of water used for disintegration is 1:0.65-7". The claimed ratio of waste paper to water is not described in the original Specification and is considered as new matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4) Claims 1, 3, 5, 49-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 now recites phrase "in which a ratio between a weight of the waste paper to be disintegrated and a weight of water used for disintegration is 1:0.65-7". The claimed ratio of waste paper to water is not clear since it is not described in the original Specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5) Claims 1, 3, 5, 49, 51, are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kimura (JP 11-293578).

Claims 1: Kimura discloses a system for disintegrating a waste paper stock in a dry condition by supplying a water mist content of 8-12% of water based on the dry waste paper (Abstract, entire document and figure). This represents a waste paper to water used ratio of (0.92) - (0.88) : (0.08) - (0.12). It is inherent or in the least it would have been obvious to one skilled in the art at the time the invention was made that the amount of water mist used by Kimura be sufficient to perform waste paper disintegration in the system of the present invention. The amount of water used in the disintegration process does not structurally differentiate the claimed system over the prior art system.

Claim 3: Kimura discloses additive such as a polyisocyanate compound added to form a substance having certain properties.

Claim 5: the amount of water to be added is a matter to be appropriate optimized during the system operation. Addition of an adhesive agent, filler and coloring of a fiber material are additions of components regularly used for manufacturing of paper articles.

Claims 49, 51: it would have been obvious to utilize vessels of any shape and structure. Product formed to be used as culture soil or as fertilizer does not structurally differentiate the present invention over the cited prior art.

6) Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura in view of Nishimura (JP 7-82686). Kimura is applied as above for claim 1, Kimura fails to disclose adding a fire retardant to waste paper pulp fibers to serve as incombustible material. Nishimura discloses adding a fire retardant to waste paper pulp fibers to serve as incombustible material (Abstract). It would have been obvious to one skilled in the art at the time the invention was made to combine the teachings of Kimura and Nishimura because such a combination would expand the applicability of the Kimura product as a flame resistant product.

Response to Amendment

7) Claims 1-5, 49-51 rejection under 35 U.S.C. 112, second paragraph, is withdrawn in view of amended claims.

8) Claims 1-5, 49, 51 rejection under 35 U.S.C. 103(a) as being unpatentable over Kimura (JP 11-293578), is withdrawn in view of amended claims.

9) Applicant's arguments filed 11/18/2008, have been fully considered but they are not persuasive.

Applicant alleges that the cited prior art, Kimura, does not disclose a ratio between a weight of the waste paper to be disintegrated and a weight of water used for disintegration to be 1:0.65-7.

Kimura discloses a system for disintegrating a waste paper stock in a dry condition by supplying a water mist content of 8-12% of water based on the dry waste paper. This represents a waste paper to water used ratio of $(0.92) - (0.88) : (0.08) - (0.12)$. It is inherent or in the least it would have been obvious that the amount of water mist used by Kimura be sufficient to perform waste paper disintegration in the system of the present invention. The amount of water used in the disintegration process does not structurally differentiate the claimed system over the prior art system.

Conclusion

10) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone no. is 571-272-1190.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

/Mark Halpern/
Primary Examiner
Art Unit 1791

Serial Number



Application No.

10/537,414

Applicant(s)

YAMADA, MASAO

Examiner

Mark Halpern

Art Unit

1791